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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,180	10/18/2001	Lydie Bougueleret	GEN-100D1	4857
23557	7590	01/05/2004	EXAMINER	
SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION 2421 N.W. 41ST STREET SUITE A-1 GAINESVILLE, FL 326066669			ROARK, JESSICA H	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/045,180	Applicant(s) BOUGUELERET ET AL.	
	Examiner Jessica H. Roark	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/486,580.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-40 are pending and under consideration in the instant application.

IDS

2. It is noted that no IDS appears to have been filed.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/486,580, filed on 2/25/2000.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention *to which the claims are directed*.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

Sequence Compliance

6. The CRF, paper copy of the Sequence Listing and Statement that the CRF and Sequence Listing are the same, filed 5/20/2002, has been entered.
7. The specification is objected to under 37 CFR 1.821(d) because the SEQ ID NOS are not disclosed in the specification adjacent referenced sequences (for example, sequences appear on page 22 of the instant specification that lack identifiers). Appropriate correction is required.

Applicant is requested to carefully review the application and drawings to confirm that all sequences are present in the sequence listing and that SEQ ID NOS are provided in the specification and figures or figure legends.

Claim Objections

8. The instant claims are objected to because of the following informalities: the format for reciting a SEQ ID NO should be consistent throughout the claims (i.e., either "SEQ ID NO:4" or "SEQ ID No. 4"). Appropriate correction is required.

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Claim Rejections - 35 USC § 112 second paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 3-7, 15-18, 23, 25-26, 28-29, 31-35, 37-38 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 1, 3-7, 15-18, 23, 25-26, 28-29, 31-32, 34-35, 37-38 and 40 each recite either directly or indirectly "wherein said isolated polypeptide". However, it is ambiguous as to which polypeptide(s) are referenced. It is suggested that Applicant amend the wherein clause of the claims to recite the subject of the preamble. For example, claim 1 could be amended to recite – wherein said isolated polynucleotide encodes a polypeptide that -- .

B) Claim 32 recites "the vector" and "the polynucleotide" in line 2. However, there is a lack of antecedent basis in the claim for these recitations. It is suggested that Applicant amend the claim to recite in each instance the indefinite article "a".

C) Claim 33 recites "the polynucleotide" in line 2. However, there is a lack of antecedent basis in the claim for these recitations. It is suggested that Applicant amend the claim to recite in each instance the indefinite article "a".

D) Applicant is reminded that any amendment must point to a basis in the specification so as not to add new matter. See MPEP 714.02 and 2163.06.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-40 of copending Application No. 10/013770. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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Conclusion

13. No claim is allowed.

14. It is noted that the polypeptide of SEQ ID NO:3 is disclosed to be a member of an art-recognized class of polypeptides known as defensins which share a conserved structure (specification pages 3-5). Defensins as a class have broad spectrum antimicrobial activity. *See e.g.*, U.S. Pat. No. 5,242,902. The instant polynucleotide encoding the DEF-X polypeptide is disclosed to be most homologous to the defensin HNP-4 (specification pages 21-22). However, the instant claims do not appear to encompass a polynucleotide encoding HNP-4, or the signal peptide, proregion or mature peptides derived therefrom.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark, whose telephone number is (703) 605-1209 (effective mid January 2004, this number will change to (571) 272-0848). The examiner can normally be reached Monday from 8:30 to 5:00, and Tuesday/Thursday from 10:00 to 4:00. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number for before Final submissions is (703) 872-9306.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
December 30, 2003

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PRIMARY EXAMINER
TECH CENTER 1600
1/2/04